



DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/814,558 03/22/01 LAZARUS

L 209897

023460

HM12/0928

LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO IL 60601-6780

EXAMINER

LUKTON, D

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/814,558

Applicant(s)

Lazarus

Examiner

David Lukton

Art Unit

1653



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Sep 17, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-20 is/are pending in the application

4a) Of the above, claim(s) 11-18 is/are withdrawn from consideration

5) ☒ Claim(s) 1-9 and 19 is/are allowed.

6) ☒ Claim(s) 10 and 20 is/are rejected.

7) ☐ Claim(s) is/are objected to.

8) ☐ Claims are subject to restriction and/or election requirements

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. .

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4

20) ☐ Other:

Pursuant to preliminary amendment, claims 1 and 2 have been amended, and claims 19-20 added. Claims 1-20 are pending, of which claims 11-18 are withdrawn from consideration.

Applicants' election of Group I with traverse is acknowledged, as is the elected specie. As previously stated (paper No. 5, mailed 8/14/01), the method claims would be rejoined with the group I claims if the latter proved to be allowable. Applicants have concluded from this that there would be no additional search burden in examining the method claims, even if the methods were different from what is taught in the reference. However, this argument is found not persuasive. If a reference teaches that compound "X" can be used in method "A", and an applicant is claiming a method of using the same compound ("X") in method "B", the search for compound "X" would have only resulted in a rejection of compound "X" per se, not the method. In such a case, a second search would have to be conducted for the method claim. However, to the extent that the compounds prove to be novel, the restriction, as well as the debate over it, will prove entirely moot.

**Revision of the abstract is required.** The abstract should be no longer than about 2/3 of a page. (The substituent variables do not have to be fully defined in the abstract).

\*

This application contains at least one sequence disclosure that is encompassed by the

definitions for amino acid sequences set forth in 37 CFR 1.821. However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 with regard to the sequence disclosures.

See, for example, the sequence on ~~sequence~~ page 26, line 21 (Tyr-Tic-Phe-Phe).

Applicant is given the time period set in this letter within which to comply with the sequence rules, 37 CFR 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period.

\*

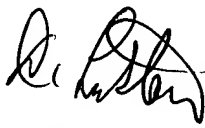
Claims 10 and 20 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The cited claims recite a composition. However, a composition must contain at least two components. It is suggested that the claims be amended to recite that a carrier is also present.

\*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
**DAVID LUKTON**  
**PATENT EXAMINER**  
**GROUP 1800**

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ✓ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ✓ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ✓ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
7. Other:

**Applicant Must Provide:**

- ✓ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ✓ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ✓ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g).

For questions regarding compliance to these requirements, please contact:

- For Rules Interpretation, call (703) 308-4216 or (703) 308-2923
- For CRF Submission Help, call (703) 308-4212
- For PatentIn software Program Support:
  - HELP DESK: (703) 739-8559, ext 508, M-F, 8 AM to 5 PM EST except holidays
  - Email: [PATIN21HELP@uspto.gov](mailto:PATIN21HELP@uspto.gov)
  - To purchase PatentIn software: (703) 306-2600

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